REMARKS

Applicants submit this Amendment in reply to the Office Action mailed July 13, 2005.

In this Amendment, Applicants amend claim 7, to more appropriately describe their invention. Claims 1-8 remain pending in the application.

In the Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention and rejected claims 1-7 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Further, the Examiner rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,885,694 to Pray et al. in view of Armor et al., "ICAtect-II: a framework for the integration of building design tools," Automation in Construction, Vol. 8, 277-289 (1999). The Examiner also advised the Applicant of the obligation to "point out the inventor and invention dates of each claim that was commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a)." Office Action, pg. 4, ¶ 1.

Applicants respectfully traverse the Examiner's rejections for at least the reasons discussed below.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that the

"support system" and "support method" in claims 1 and 7, respectively, have "insufficient antecedent basis for this limitation in the claim[s]." Office Action, pg. 2, ¶¶ 4-5. Applicants note that the preambles for the claims 1 and 7 recite "[a] design support system" and "[a] design support method," respectively. (Emphasis added). Accordingly, "design support system" and "design support method" are each preceded by the indefinite article "a," and thus, proper antecedent basis has been provided. If the Examiner was insinuating that no antecedent basis exists in the specification for these terms that position is also incorrect. Antecedent basis for both "a design support system" and "design support method" exist throughout the specification, e.g., page 2, line 21; page 21, lines 2 and 24-28; page 5, line 7, and so on. Therefore, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

If the Examiner maintains the rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, the Applicants respectfully request the Examiner to suggest corrections to remove any antecedent basis problems. See M.P.E.P. § 2173.05(e) at 2100-212 (Rev. 2, May 2004).

Claim Rejections Under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully disagree with this rejection. For the reasons set forth below, Applicants respectfully request that the Examiner withdraw the rejection.

Beginning on Page 3 of the Office Action, the Examiner states that "[c]lams 1-7 . . . are not statutory because they merely recite a number of computing steps without

producing any tangible result and/or being limited to practical application within the technological arts. *Citing* M.P.E.P. § 2106.IV.B.1(a) (Rev. 2, May 2004). Further, the Examiner states that "the use of a computer has not been indicated" and that any "software must be computer-readable." Office Action, page 3, ¶¶ 2-3 (emphasis in original). Applicants respectfully disagree for at least the following reasons.

The U.S. Supreme Court has stated that Congress intended statutory subject matter to "include anything under the sun that is made by man." *See Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). The Supreme Court, however, also noted three exceptions that constitute the following categories of unpatentable subject matter: "laws of nature, natural phenomena, and abstract ideas." *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

According to the Federal Circuit, the proper inquiry under 35 U.S.C. § 101 is to determine whether the claim includes recitations that produce "a concrete, tangible and useful result." *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). If so, the claim is not abstract and has practical utility (*id.*), and, if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101. *Id.; see also* M.P.E.P. § 2106(IV)(B)(2)(b)(ii) (8th Ed., Rev. 2, May 2004) ("A claim is limited to a practical application [i.e., is directed to statutory subject matter,] when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible, and useful."). Thus, for example, "[a] method of controlling parallel processors to accomplish multi-tasking of several computing tasks to maximize computing efficiency"

is statutory subject matter. M.P.E.P. 2106(IV)(B)(2)(b)(ii) at 2100-18 (8th Ed., Rev. 2,

May 2004) (citing In re Bernhart, 417 f.2d 1395, 1400, 163 USPQ 611, 616 (CCPA

1969)).

Turning to claims 1 and 7 (as amended), each claim contemplates a design

support system which encompasses a computer. See, for example, Specification, page

5, lines 8-15, and Fig. 1. Further, claims 1 and 7 provide a design support system that

retrieves graphic element data to recreate graphic data in an efficient and convenient

manner. Accordingly, claims 1 and 7 produce a concrete, tangible and useful result.

See M.P.E.P. 2106(IV)(B)(2)(b)(ii) at 2100-18 (8th Ed., Rev. 2, May 2004). For these

reasons, the rejection under 35 U.S.C. § 101 is improper and should be withdrawn.

Thus, claim 1 and 7 recite statutory subject matter under 35 U.S.C. § 101 and

claims 2-6 recite statutory subject matter at least by virtue of their dependence upon

independent claim 1.

Claim Rejections Under 35 U.S.C. § 103(a)

Initially, Applicants note that the Examiner has stated that "this application

currently names joint inventors" and advises the Applicant of "the obligation under 37

CFR 1.56 to point out the inventor and invention dates of each claim that was not

commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 34 U.S.C. 103(c)." Office Action, pg. 7, ¶ 2. Applicants

maintain that each claim was commonly owned at the time of invention.

Further, Applicants respectfully traverse the Examiner's rejection of claims 1-8

under 35 U.S.C. § 103(a) as being unpatentable over Pray et al. in view of Armor et al.

Applicants submit that claims 1-8 are patentable over <u>Pray et al.</u> and <u>Armor et al.</u> This is true whether each reference is considered alone or in any proper combination.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness cannot be established for claims 1-8 because, among other things, neither <u>Pray et al.</u> nor <u>Armor et al.</u>, nor their combination, teaches or suggests each and every feature of Applicants' claims. For example, regarding claims 1, 7, and 8, <u>Pray et al.</u> and <u>Armor et al.</u> fail to teach or suggest "<u>retrieving</u> a corresponding work procedure data portion within another design file with ID, . . . and . . . <u>comparing</u> a work procedure data portion . . . with contents of another design file <u>when a corresponding work procedure data portion is not retrieved by the first retrieval module</u> and retrieving a corresponding work procedure data portion on the basis of the compared result," as recited in claim 1, 7, and 8. (Emphasis added). Nowhere in <u>Pray et al.</u> or <u>Armor et al.</u> is performing the above mentioned retrieval procedure in two steps as in claims 1, 7, and 8. Therefore, <u>Pray et al.</u> or <u>Armor et al.</u> fail to teach or suggest "<u>retrieving</u> a corresponding work procedure data portion within another design file with

ID, . . . and . . . comparing a work procedure data portion . . . with contents of another design file when a corresponding work procedure data portion is not retrieved by the first retrieval module and retrieving a corresponding work procedure data portion on the basis of the compared result," as recited in claim 1, 7, and 8. (Emphasis added). Accordingly, claims 1, 7, and 8 are allowable over the applied references. Further, claims 1-6 are allowable at least by virtue of their dependence upon independent claim 1.
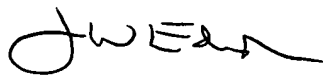
Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: October 6, 2005   By:_____
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